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**PATENT APPLICATION**

Reinhart Boerner Van Deuren s.c.

By: /Linda Kasulke/  
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Date: December 2, 2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**GROUP ART UNIT: 1794**

**EXAMINER: Patricia L. Nordmeyer**

In re application of:                     )  
John P. Downs                             )  
Application No: 10/770,139             )  
   )  
Filed: 02/02/2004                        )  
   )  
Confirmation No.: 9662                  )  
   )  
Attorney Docket No. 5398-CIP-        )  
CON-3                                        )  
   )  
Customer No. 22922                     )

For: THERMOPLASTIC  
ADHESIVE  
DISPENSING METHOD  
AND APPARATUS

Mail Stop Reply Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF**

Dear Sir,

This Reply Brief is in response to the Examiner's Answer entered on October 3, 2008. Since this Reply Brief is being filed on or before December 3, 2008 it is timely.

## DISCUSSION

The Examiner maintained the rejection of claims 1, 3, 5, 7, 9-14, 16 and 20 as allegedly obvious under 35 U.S.C. § 103(a) over U.S. Patent 3, 741,786 (Torrey). The Examiner's rejection is legally and factually erroneous and should be reversed.

Reliance is placed upon all of the arguments set forth in the Appeal Brief filed August 28, 2008. The following arguments are in response to specific points made by the Examiner in the Examiner's Answer.

**A. Torrey does not teach or suggest the claim feature “each of the adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed”**

Appellant argued at pages 8-10 of the Appeal Brief that each of the functional features set forth in the claims, including the above noted feature, is not “intended use” language as asserted by the Examiner, but rather the functional language imposes structure on the claimed adhesive dispensing tape. The Examiner has essentially ignored the argument, merely stating that if the “prior art structure is capable of performing the intended use, then it meets the claim.” Examiner's Answer, page 6. The Examiner does not explain how the structure described in Torrey meets any of the functional features of the claimed adhesive dispensing tape. Nor can she as Torrey does not provide sufficient details of that adhesive tape so that one can determine whether the Torrey structure is capable of the functions set forth in the claims. See Appeal Brief, pages 14-15.

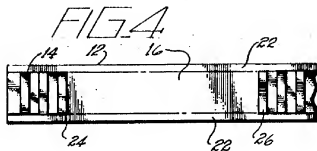
The Examiner refers to column 6, lines 32-33 of Torrey as allegedly describing that “any portion of the adhesive may be dispensed.” Examiner's Answer, page 6. The Examiner has misread Torrey.

The cited passage in Torrey reads in its entirety;

First of all, with reference to FIG. 4, any portion of the adhesive can be transferred, such as the portion between segments 24 and 26, from the carrier tape

to a substrate, without cutting the carrier tape or the adhesive. The applied adhesive will be uniform in nature, not stretched, stringed or distorted.

Fig. 4 of Torrey is:



The segment of adhesive that was removed between **24** and **26** clearly comprised more than one of the individual bars illustrated. That multiple bars of adhesive constitute the “portion” removed is supported by reading Torrey in its entirety. For example, Torrey at column 6, lines 46-58 states:

An even more significant advantage of the substantially non-contiguous nature of the applied pressure sensitive adhesive segments is that they function as discrete adhesive segments and therefore any change in dimension due to humidity, temperature or the like remain localized and are not propagated throughout a continuous mass of adhesive. This prevents shrinking and curling of substrates bonded by the pressure sensitive segments, as for instance, when it is employed to bind thin sheets of paper. Expansion, shrinking and curling on a substrate, on the other hand, can be experienced where an adhesive is applied as a continuous layer.

The proper way to read Torrey is that, where the prior art would have applied a continuous sheet of adhesive covering X area, the continuous sheet of adhesive is divided into a *plurality of discrete segments* of adhesive covering X area and the *plurality of discrete segments* are applied to the substrate. It is only in that manner that the benefits ascribed to the Torrey tape by Torrey can be achieved. If a single discrete portion of adhesive is applied to cover X area as featured in the rejected claims, the result would be a continuous layer of adhesive which is not the Torrey invention.

The Examiner's rejection is based upon speculation, not facts and should be reversed. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967).

**B. The examiner's new reliance upon MPEP 2144.04 I. and IV. is misplaced**

The Examiner newly relies upon these passages of the MPEP at pages 6-7 of the Examiner's Answer. MPEP 2144.04 I. is directed to "AESTHETIC DESIGN CHANGES" and cites *In re Seid*, 161 F.2d 229 (CCPA 1947) where it is stated "[t]he court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art." This section also cites *Ex parte Hilton*, 148 USPQ 356 (Bd. App. 1965) where the Board held "the shape (chips) is important because it results in a product which is distinct from the reference product (french fries) "

MPEP 2144.04 IV. is directed to "CHANGES IN SIZE, SHAPE OR SEQUENCE OF ADDING INGREDIENTS." This section cites *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), stating "the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device" and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of

ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.).

Both of these sections and the cases cited therein are inapposite to the present facts as the functional language relied upon imposes structure on the claimed adhesive dispensing tape. The imposed structure structurally distinguishes the claimed tape from the tape described in Torrey as it provides that the individual adhesive segments are individually exposable and dispensable.

If any section of the MPEP is relevant to the issue of the weight to be given to functional language it is MPEP 2111.04 which makes clear that this determination is based upon the facts of each case. Here the Examiner merely cites to two sections of the MPEP and does not provide a fact-based explanation why any of the cases cited therein are relevant to present facts. In discussing two claim features that were argued in the Appeal Brief, the Examiner merely dismisses them as an “obvious matter of design choice.” Examiner’s Answer, 7. This is error on the part of the Examiner as the Examiner ignores the fact that functional language imposes structure on the claimed tape which is not suggested by Torrey.

### **Conclusion**

The Examiner’s conclusion of obviousness is based upon speculation not facts and does take into account the claim language. Thus, the rejection should be reversed.

Appellant respectfully requests that each of the obviousness rejections advanced in the Final Office Action dated October 30, 2007, be reversed and withdrawn and that the Application move forward toward issuance.

Respectfully submitted:

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